

16.94

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Bigham, et al.

Filed: October 23, 2001

Art Unit: 1626

Serial No.: 10/019,976

Examiner: G. Shameem

For: Imidazoline Derivatives As Alpha-1A Adrenoceptor Ligands

**FAX RECEIVED**

**OCT 28 2003**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITIONS OFFICE**

**PETITION TO THE COMMISSIONER UNDER 37 C.F.R. 1.144**

Sir:

This is a petition of the final office action maintaining an objection of Claims 1-17, 19, and 20. This final action was mailed September 15, 2003. Since this final action is characterized solely as an objection, Applicants may not be able to appeal to the Board. In addition, this is a situation in which the supervisory authority of the Commissioner is appropriate. Therefore, this Petition is proper under 37 C.F.R. § 1.144 and 1.181. Applicants hereby petition the Commissioner to take the following action.

**I. POINTS TO BE REVIEWED**

The Commissioner is requested to review the propriety of the Examiner's actions with respect to the Restriction Requirement, Election of Species and refusal to examine claims as more precisely set forth in Sections II, III and IV below.

**II. ACTION REQUESTED**

Petitioner hereby requests

- (1) that the Commissioner order the Examiner to withdraw the objections to the claims set forth in the Office Action mailed September 15, 2003;
- (2) that the Commissioner order the Examiner to examine the entire scope of claims 1-17, 19 and 20; and

found not allowable. Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability....

...The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim....  
(Emphasis added.)

MPEP § 803.02 requires the Examiner to search and examine the Markush-type claim until an unpatentable species is discovered, even if the claim contains independent and distinct inventions. The fact that the various compounds may be classified in different subclasses by the USPTO and that different fields of search may be involved does not mean that the Markush group is improper, In re Brouard, 201 USPQ (BNA) 538, 540 (Pat. & Trademark Off. Bd. App. 1977). Therefore, the entire scope of claim 1 should be examined. To the extent that the Code of Federal Regulations (particularly 37 CFR 1.142 and 1.146) and the MPEP are being interpreted in a manner inconsistent with the statutory law (35 USC and due process) and the cases cited in this petition, the regulations of the PTO and the procedures suggested in the MPEP are invalid and should be withdrawn by the USPTO.

#### V. CONCLUSION

For the foregoing reasons, the Commissioner is requested to grant the relief requested in Section II above.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 07-1392 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

*Robert H. Brink*

Robert H. Brink  
Attorney for Applicants  
Registration No.: 36,094

Date: *October 28, 2003*  
GlaxoSmithKline  
Five Moore Drive  
Research Triangle Park  
North Carolina 27709  
(919) 483-3323